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| APPLICATION NO.                          | FI   | LING DATE  | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |  |
|--|------|------------|----------------------|---------------------|------------------|--|
| 09/926,614 11/26/200                     |      | 1/26/2001  | Toshio Isozaki       | 215299US0XPCT       | 6319             |  |
| 22850                                    | 7590 | 12/23/2003 |                      | EXAMINER            |                  |  |
|  |      | MCCLELLAND | CAIN, EDWARD J       |                     |                  |  |
| 1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |      |            |                      | ART UNIT            | PAPER NUMBER     |  |

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary    Examiner   Edward J Calm   International Content of the    |   | Application No.        | Applicant(s)                               |     |  |  |  |  |  |
|--|---|------------------------|--|-----|--|--|--|--|--|
| ## Examiner   Examine    | •   | 1                      |  | 2   |  |  |  |  |  |
| Edward J. Cain  The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  Period for Reply  A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  Edwards of time may be available under the provisions of 37 CFR 1.136(a), in no event, however, may a reply be timely filed after 50°C, MONTHS from the maining date of the communication and the 50°C, MONTHS from the maining date of the communication of the 50°C, MONTHS from the maining date of the communication of the 50°C, MONTHS from the maining date of this communication.  If NO period for reply is specified above, the maximum altalutory pierds will apply and vell expire SIX (8) MONTHS from the maining date of this communication. Failure for reply within the set or canded particle from yellow the specified shows. The maining date of this communication, even if timely fleet, may reduce they rearried particle from the maining date of this communication, even if timely fleet, may reduce they rearried particle from adjustment. See 37 CFR 1.704(a).  Status  1) Responsive to communication(s) filed on   | Office Action Summary   |                        |  |     |  |  |  |  |  |
| Period for Reply  A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ② MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  E-beausinos of firm may be available under the proteins of 37 CPR 1.136(a), in no event, however, may a reply be timely filled by the state of the may be available under the proteins of 37 CPR 1.136(a), in no event, however, may a reply be timely filled by the period for reply a specified above, the measurement statetory period upply and will explore all the proteins of the reply to append above, the measurement statetory period upply and will explore all the proteins of the reply to append above, the measurement statetory period upply and will explore all the proteins of the measurement of the proteins of the     | Office Action Summary   |                        |  | (3) |  |  |  |  |  |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ② MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Brite SIX (8) MONTH S from the malling date of this communication.  - Brite SIX (8) MONTH S from the malling date of this communication.  - Brite SIX (8) MONTH S from the malling date of this communication.  - Brite SIX (8) MONTH S from the malling date of this communication.  - Brite SIX (8) MONTH S from the malling date of this communication.  - Brite SIX (8) MONTH S from the malling date of this communication.  - Brite SIX (8) MONTH S from the malling date of this communication.  - Brite SIX (8) MONTH S from the malling date of this communication.  - Property of the state of the state of the state of this communication.  - Any reply received by the Office Jobs the final them cannot after the malling date of this communication, even if simely filed, may reduce any searned patient term adjustment. See 37 CFR 1.78(6).  - Status  1)   | The MAILING DATE of this communication an   |                        |  | ess |  |  |  |  |  |
| THE MAILING DATE OF THIS COMMUNICATION.  Edenations of the may be expecialled under the processions of 3 CFR 1.36(a), in no event, however, may a reply be limitly filed after \$10.00 hCM prits from the mailing date of this conversions of 3 CFR 1.36(a), in no event, however, may a reply be limitly filed after \$10.00 hCM prits from the mailing date of this conversion of the prits as period after \$10.00 hCM prits from the mailing date of this conversion of the prits as period above, the mailing date of this conversion of the prits as period above, the mailing date of this conversion of the prits as period above, the mailing date of this conversion of the prits of |   |                        | · · · · · · · · · · · · · · · · · · ·      |     |  |  |  |  |  |
| 1) Responsive to communication(s) filed on  2a) This action is FINAL. 2b) This action is non-final.  3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4) Claim(s) 1-10 is/are pending in the application.  4a) Of the above claim(s) is/are withdrawn from consideration.  5) Claim(s) is/are allowed.  6) Claim(s) 1-3 and 7-10 is/are rejected.  7) Claim(s) is/are rejected.  7) Claim(s) and Y-10 is/are rejected.  7) Claim(s) and Y-10 is/are rejected.  7) Claim(s) and Y-10 is/are rejected.  7) Claim(s) are subject to restriction and/or election requirement.  Application Papers  9) The specification is objected to by the Examiner.  10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. §§ 119 and 120  12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Some *c) None of:  1. Certified copies of the priority documents have been received.  2. Copies of the certified copies of the priority documents have been received in Application No  3. Copies of the certified copies of the priority documents have been received.  13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.  37 CFR 1.78.  4) The translation of the foreign language provisional application has been recei  | THE MAILING DATE OF THIS COMMUNICATION.  Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any |                        |  |     |  |  |  |  |  |
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| Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. §§ 119 and 120  12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Some * c) None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No.  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet.  37 CFR 1.78.  a) The translation of the foreign language provisional application has been received.  14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  Attachment(s)  1) Notice of References Cited (PTO-892)  4) Interview Summary (PTO-413) Paper No(s).  5) Notice of Informal Patent Application (PTO-152)  |   |                        |  |     |  |  |  |  |  |
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| 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 4) Interview Summary (PTO-413) Paper No(s) 5) Notice of Informal Patent Application (PTO-152)  | a)  |                        |  |     |  |  |  |  |  |
| 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  5) Notice of Informal Patent Application (PTO-152)  | ,   | a, □                   | tantiau Cummani (PTO 442) P No(-)          |     |  |  |  |  |  |
|  | 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) 🔲 No                | otice of Informal Patent Application (PTO- |     |  |  |  |  |  |

Application/Control Number: 09/926,614

Art Unit: 1714

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-3 and 7-10 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 2, 4 and 6-10 of copending Application No. 09/857,865. This is a <u>provisional</u> double patenting rejection since the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Mark et al.

Mark et al disclose polycarbonate compositions comprising organophosphorous compounds meeting the limitations of applicants formulae 1 and 2 (see columns 1 and 2). The further incorporation of common adjuvants is disclosed at column 4, lines 59-63 which adjuvants are seen as meeting the instant limitation to anti-drip agents. These compositions are further taught as suitable for the formation of electronic parts.

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Claims \$46\$ are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Cain whose telephone number is (571) 272-1118. The examiner can normally be reached on M-F from 10:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

EDWARD J. CAST PRIMARY EXAMINER GROUP 1500 Edward J. Cain Primary Examiner Art Unit 1714